

**REMARKS**

Claims 1 and 3-14 are pending, with claims 9-12 withdrawn from consideration. Claims 1, 6-8 and 13 are amended. Claim 13 is amended to address a rejection under 35 USC 112; claims 6 and 7 are amended to depend from claim 1 instead of canceled claim 2; and claim 8 is amended to maintain consistency with claim 1.

No new matter is added to the application by this Amendment. The new features added to claims 1 and 13 find support in canceled claim 2 and Fig. 3, as originally filed, of the present application.

Reconsideration of the application is respectfully requested.

**I. Rejection Under 35 USC 112**

Claim 13 was rejected under 35 USC 112, second paragraph, as allegedly being indefinite for allegedly failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. This rejection is respectfully traversed.

Claim 13 was amended to address this rejection. Applicants submit that amended claim 13 is definite, particularly points out and distinctly claims the subject matter which Applicants regard as the invention, and overcomes this rejection.

Thus, Applicants respectfully request withdrawal of the rejection under 35 USC 112, second paragraph.

**II. Rejection Under 35 USC 102**

Claims 1 and 3-5 were rejected under 35 USC 102(b) as allegedly being anticipated by US Patent Publication No. 2005/0180704 to Terry et al. (hereinafter "Terry"). Applicants respectfully traverse this rejection.

The Patent Office alleges that Terry discloses each and every feature of the foregoing claims. Applicants respectfully disagree with the allegations by the Patent Office as set forth in the Office Action.

Amended claim 1 incorporates the features of canceled claim 2, as originally filed, which was not rejected under 35 USC 102(b) as allegedly being anticipated by Terry.

As acknowledged by the Patent Office's failure to reject canceled claim 2 as allegedly being anticipated by Terry, Terry does not disclose the features specifically required by amended claim 1.

Terry fails to disclose that a first side of the first outer layer A is connected to a separate layer C over an entire area of the first side of the first outer layer A, wherein the layer C is firmly connected on an open side to a separate second outer layer B over an entire area of a first side of the second outer layer B as required by amended claim 1.

Because the features of independent claim 1 are neither taught nor suggested by Terry, Terry cannot anticipate, and would not have rendered obvious to one of ordinary skill in the art, the features specifically defined in claim 1 and its dependent claims.

In view of the foregoing, withdrawal of this rejection is respectfully requested.

**III. Rejection Under 35 USC 103**

Claims 2, 6-8, 13 and 14 were rejected under 35 USC 103(a) as allegedly being unpatentable over Terry. This rejection is respectfully traversed.

The Patent Office alleges that each and every feature of the foregoing claims would have been obvious to a skilled artisan at the time of the invention in view of the teachings of Terry. Applicants respectfully disagree with the allegations by the Patent Office as set forth in the Office Action.

The features of canceled claim 2, which was rejected under 35 USC 103(a) in view of Terry, were incorporated into amended claim 1. Therefore, Applicants take this opportunity to address amended claim 1 in view of the teachings of Terry.

Terry teaches a tape having super absorbent layer sandwiched between an open cell layer and support layer as shown in Fig. 3. Additionally, Terry teaches a tape having an additional super absorbent layer and open cell layer on an open side of the support layer. Nowhere does Terry teach an open cell layer having a second support layer located on a side located opposite to the super absorbent layer and the first support layer.

The Patent Office acknowledges that Terry fails to teach such a second support layer located on the side opposite to the super absorbent layer and the first support layer. However, the Patent Office alleges (a) that it would have been obvious to a skilled artisan at the time of the invention to allegedly provide a support layer on an open cell layer 10 for added protection or mechanical, (b) that providing a second support layer would have allegedly achieved expected results such as protection or mechanical strength and (c) that the resulting structure of Terry allegedly teaches a layer C that is firmly connected on an open side to a second

separate outer layer B over an entire area of the first side of the outer layer B. See pages 5 and 6 of the present Office Action.

A skilled artisan would have not been motivated to modify Terry's tape to include a second support layer as alleged by the Patent Office because the resulting tape (i.e., a tape having a structure of a super absorbent layer and open cell layer sandwiched between two support layers) would have been inoperable for Terry's intended uses. The intended uses of Terry's tape are identified in the following passages:

“The inner core of the cable is surrounded by the tape with the **side of the open cell layer** distal from the super absorbent layer **facing the inner core**” (see the Abstract);

“Optical and power cables have inner cores that are surrounded by the inventive tapes. The **inner core is facing the open cell layer** on the side without the super absorbent material. The inventive tape may be applied in a wound or longitudinal layered fashion” (see paragraph [0014]);

“...In typical applications the **open layer presents a smooth surface that shields the inner cable core elements** (the power or information carrying elements within the cable) from the rough SAP particles. Moreover, the **open layer is conformable to the inner cable core elements when applied**, thereby holding and securing those elements in position” (see paragraph [0029]);

“In an assembled cable the inventive tape may be used as a buffer layer in optical fiber cables with the **smooth surface of the open layer directly in contact with the optical fiber**. As mentioned above, the inventive cable will prevent the SAP material from reaching the cable core. The smooth surface of the open layer compression on the cable can be tailored to the cable requirements **allowing the open layer to grip the cable core** and create a mechanical bridge between the cable core and the outer cable strength elements...” (see paragraph [0053]); and

“...For such cables, the inventive tape **open layer provides some relief** from thermo mechanical expansion and contraction under cable load cycling... The **open layer 78 provides thermal endurance and support** for the outer layers found in some cables, for example, outer layers of metal wire screens, corrugated metal sheaths and helical metal armor...” (see paragraph [0057]). (Emphasis Added)

It is clear from the above-mentioned passages, the intended uses of Terry's tape and open cell layer, having a smooth surface, include applying Terry's open cell

layer to an inner core of the cable or optical fiber so that the smooth surface is facing and in direct contact with the cable or fiber. By doing so, Terry's open cell layer and its smooth surface are used to shield the inner cable core elements from the rough SAP particles and to hold and secure those elements in position. Additionally, Terry's open cell layer and its smooth surface are used to create a mechanical bridge between the cable core and outer cable strength elements, and to provide thermal endurance and relief from thermo mechanical expansion and contraction.

None of these above-identified intended uses for Terry's tape would have been achievable if Terry's tape would have been modified so that the open cell layer (with its smooth surface) is sandwiched between two support layers as alleged by the Patent Office. A skilled artisan would never have modified Terry's tape to have an open cell layer (with its smooth surface) sandwiched between two supporting layers because such modified tape would have been completely **inoperable for its above-identified intended uses**. As set forth in MPEP § 2143.01 (V):

“If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, ***there is no suggestion or motivation to make the proposed modification.***”

This legal principle is well-settled and finds ample support in the case law. See, *In re Kramer*, 18 USPQ2d 1415, 1416 (Fed. Cir. 1991) (“[I]t is equally true that if the *teachings* of a prior art reference would lead one skilled in the art to make a modification which would render another prior art device inoperable, then such a modification would generally not be obvious (italics in original).”) See, also, *In re Gordon*, 221 USPQ 1125, 1127 (Fed. Cir. 1984) (Apparatus, which was required to be turned upside down to meet the terms of the claims, but, by such action would be

"rendered inoperable for its intended purpose," in effect "teaches away from the board's proposed modification.")

Accordingly, Applicants respectfully submit that a person of ordinary skill in the art would not have been motivated to modify Terry to achieve the presently claimed invention as alleged by the Patent Office , and a *prima facie* case of obviousness cannot be established. Therefore, Applicants respectfully request that the Patent Office withdraw this rejection.

**IV. Conclusion**

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1 and 3-14 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Early and favorable action is earnestly solicited.

**CONDITIONAL PETITION FOR EXTENSION OF TIME**

If entry and consideration of the amendments above requires an extension of time, Applicants respectfully request that this be considered a petition therefor. The Commissioner is authorized to charge any fee(s) due in this connection to Deposit Account No. 14-1263.

**ADDITIONAL FEE**

Please charge any insufficiency of fees, or credit any excess, to Deposit  
Account No. 14-1263.

Respectfully submitted,  
NORRIS MC LAUGHLIN & MARCUS, P.A.

By /Brian C. Anscomb/  
Brian C. Anscomb  
Reg. No. 48,641  
875 Third Avenue, 8<sup>th</sup> Floor  
New York, New York 10022  
Phone: (212) 808-0700  
Fax: (212) 808-0844